

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Andrew C. Gilbert (deceased)  
Application No. : 10/042,371 Confirmation No. : 6761  
Filed : December 27, 2001  
For : CREATING AND TRADING DYNAMIC SECURITIES  
Group Art Unit : 3691  
Examiner : Chuks N. Onyezia

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant requests review of the Final Rejection of February 20, 2009 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

**REMARKS**

The Examiner rejects the pending claims under 35 U.S.C. § 103(a) as being unpatentable over Pritchard, U.S. Patent Application Publication No. 2002/0046154 (hereinafter Pritchard), in view of Lipper, U.S. Patent No. 7,487,122 (hereinafter Lipper). The Examiner's failure to establish a *prima facie* case of obviousness of any of the claims results in clear error.

**I. The Examiner fails to show that the references disclose all the limitations of at least claims 14 and 43**

To establish a *prima facie* case of obviousness of a claimed invention, the Examiner must show that all limitations of a claim are taught or suggested by the prior art. Independent claim **14**, and similarly independent claim **43**, recite in part:

*determining that the rate of return of the at least one asset deviates from the pre-determined target rate of return by at least a pre-determined amount;*

In rejecting claim **14** (and apparently claim **43**), the Examiner asserts in part that the

examiner interprets Lipper does disclose displaying the determination of the return of a security based on being indexed by another security and that the rate of return deviates by at least 0.1 according to the decimal places listed. Office Action, paragraph 5, page 4.

The Examiner appears to assert that Lipper discloses displaying the deviation of a rate of return of a security, as indexed by another security, using 0.1 increments. Even assuming, *arguendo*, that Lipper discloses such features, displaying deviations using 0.1 increments is not “*determining that the rate of return of the at least one asset deviates from the pre-determined target rate of return by at least a pre-determined amount.*”

Because the Examiner fails to show that the references disclose all the limitations of claims **14** and **43**, the Examiner fails to establish a *prima facie* case of obviousness of these claims, and claims **13, 15-17, 42, 44-46, 48-61, and 67-80**, which depend there from.

## **II The Examiner fails to provide any evidence of record to support the Examiner's purported motivation for combining the references**

In a determination of obviousness, the Examiner must support all factual findings with substantial evidence of record. In re Zurko, 258 F.3d 1379, 1383-84 and 86 (Fed. Cir. 2001). The Supreme Court has reiterated that mere conclusory statements are insufficient on which to base a conclusion of obviousness. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-42 (S.Ct. 2007). Even the MPEP clearly articulates that an obviousness rejection must be based on factual findings supported by substantial evidence of record. See e.g., MPEP §§ 2141(II) and 2144.03.

In rejecting claim **14** (and apparently all other pending claims), the Examiner asserts:

It would have been obvious to combine the teachings of Lipper with Pritchard for the purpose of facilitating a financial management system for administrating investment instruments that can be traded. Office Action, paragraph 5, page 5.

The Examiner appears to refer to the Abstract of Pritchard as a basis for this purported motivation for combining the references. While the Abstract of Pritchard appears to refer to a financial management system for administrating investment instruments that can be traded, the Abstract of Prichard makes no reference to “facilitating” such a system. On the contrary, the Examiner’s assertion that one of ordinary skill in the art would be motivated to combine the references in the manner recited by the claims based on the purported motivation that it would “facilitat[e]” the system of Pritchard is purely conclusory, unsupported by the Examiner with any evidence of record. As clearly articulated by the MPEP, and by the Supreme Court and the Federal Circuit, examiner statements unsupported by any evidence of record are insufficient to establish a *prima facie* case of obviousness.

## **III. The Examiner fails to set forth in the written record any factual findings of how the references disclose all the limitations of at least claims 25, 61, 63-65, and 80**

To establish a *prima facie* case of obviousness of a claimed invention, the Examiner must show that all limitations of a claim are taught or suggested by the prior art. Further, the MPEP reads in part:

When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact

concerning the state of the art and the teachings of the references applied.... Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. MPEP § 2141(II).

In rejecting claims **25, 61, 63-65, and 80**, the Examiner merely asserts that the claims are “rejected using logic similar to that used in the rejection of claims 13-17.” Office Action, paragraph 16, page 8. Claims **25, 61, 63-65, and 80** are directed in part at “*the rate of return of [a] dynamic security.*” On the contrary, claims **13-17** do not recite such limitations but rather, are directed in part at the rate of return of one or more assets that make up a dynamic security. Accordingly, the “logic ... used in the rejection of claims 13-17” does not include factual findings by the Examiner as to how the references disclose all the limitations of claims **25, 61, 63-65, and 80**. Because the Examiner fails to set forth in the written record factual findings of how the references disclose all the limitations of claims **25, 61, 63-65, and 80**, the Examiner fails to establish a *prima facie* case of obviousness of these claims, and claims **21-22, 26, 28, 62, and 66**, which depend from claim **25**.

In addition, Applicant is unable to respond to the rejection of at least claims **25, 61, 63-65, and 80** because the Examiner fails to notify Applicant of the Examiner’s basis for the rejection. As important, Applicant is not required to guess at the Examiner’s position.

**IV. The Examiner fails to show that the references disclose all the limitations of claims 52, 62, and 71**

Claim **52**, and similarly claims **62** and **71**, recite:

*based at least in part on purchasing the selected assets, displaying the purchased assets to the user via the first computing device, wherein the purchased assets are displayed to the user so as to show that the purchased assets are part of the dynamic security.*

In rejecting claim **52** (and apparently claims **62** and **71**), the Examiner asserts that such limitations are disclosed at Lipper Figure 4 and column 7, lines 3-5, which reads:

As shown in FIG. 4, the user can select the array of values to be considered in each of the screens shown in FIGS. 2-3 simply by right-clicking the mouse and making the appropriate selections.

No where in the cited portions of Lipper does Lipper make any reference to “*purchasing/purchased assets*” and as such, the cited portions of Lipper do not disclose the above noted limitations of claims **52**, **62**, and **71**. Because the Examiner fails to show that the references disclose all the limitations of claims **52**, **62**, and **71**, the Examiner fails to establish a *prima facie* case of obviousness of these claims.

**V. The Examiner fails to show that the references disclose all the limitations of claims 48 and 67**

Claims **48** and **67** recite “*wherein the user specifies the pre-determined amount.*” In rejecting claim **48** (and apparently claim **67**), the Examiner asserts that such limitations are disclosed at Lipper column 6, lines 21-29. As noted by the rejection of claim **14**, the Examiner appears to equate “*the pre-determined amount*” of claims **48** and **67** to the 0.1 increments used in displaying the deviation of a rate of return of a security, as allegedly disclosed by Lipper. No where in the cited portions of Lipper does Lipper make any reference that the user specifies the 0.1 increments. As such, the cited portions of Lipper do not disclose the limitations of claims **48** and **67**. Because the Examiner fails to show that the references disclose all the limitations of claims **48** and **67**, the Examiner fails to establish a *prima facie* case of obviousness of these claims.

**VI. Conclusion**

The Examiner’s failure to establish a *prima facie* case of obviousness of any of the claims results in clear error. Withdrawal of the rejection is respectfully requested.

Respectfully submitted,

April 22, 2009  
Date

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